

## REMARKS

The eleven claims of the present application have been made subject to a restriction requirement. Specifically, the Official Action avers that eight separate inventions are embodied by the claims of the present application. Suffice it to say, the first seven of these alleged inventions, Groups I-VII, are each directed to Claims 1 to 7. The distinction between the alleged separate inventions of Groups I to VII resides in the alleged distinct nature of the meanings of Formula I when radicals Y and R<sup>1</sup> and R<sup>2</sup> are dissected into seven alleged different classes of compounds, albeit the broadest claim of the application defines Y as having all the meanings of the seven separate inventions.

Applicants have elected Group V, encompassing Claims 1 to 7, drawn to compounds of formula I where Y is phenyl or naphthalene and R<sup>1</sup> and R<sup>2</sup> do not form a ring, compositions and methods of use thereof for prosecution on the merits in this application. Applicants make this election with traverse.

The basis for this restriction requirement is predicated on Rule 13.2 of the Patent Cooperation Treaty (PCT). That rule requires that there be a technical relationship among a group of inventions which involve one or more of the same or corresponding technical features. The term "special technical features," in Rule 13.2, means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The Official Action avers that a technical feature which already forms part of the state of the art cannot, by definition, make a contribution over the prior art and does not, therefore, qualify as a unifying element in the sense of Rule 13.1. The Official Action basis for the conclusion that the technical feature linking the invention embodied by Claims 1 to 7 is part

of the prior art. This conclusion is predicted upon the allegation that the different meanings of  $R^1$  and  $R^2$  in Formula I are prior art against each other.

Applicants believe that this ground of rejection is not sustainable. The allegation that the technical feature linking the inventions, and thus overcoming the absence of unity of invention, cannot be advanced because it already is prior art is totally unreasonable.

It is obvious that a class of radicals in a generic formula present a prima facie case of obviousness where a generic formula encompassing one of those radicals is available in the prior art over other compounds having the same generic formula where one or more of the remaining radicals are set forth. However, there is nothing in the outstanding Official Action which supports the allegation that any of the meanings of  $R^1$  and  $R^2$  in generic Formula I are known in the art. Indeed, that issue is decided in the substantive examination of the application.

Although applicants have difficulty in framing a response to what they perceive to be an illogical basis for restriction, they rely, in part, upon the International Preliminary Examination Report, issued in the present application. That examination, directed to the parent PCT application, Application No. PCT/US 00/15072, did not find any lack of unity of the claims of the present application. As such, the authorities having special skill in application of the PCT rules did not find any basis for restriction. As such, the basis for restriction imposed in the outstanding Official Action is totally unsupported by the earlier examination.

It is also mentioned in passing that it is generally accepted that the rules for unity of invention under the Patent Cooperation Treaty are far more liberal than under U.S. patent practice. That no basis for lack of unity supporting the outstanding restriction requirement

has been imposed, under Section 37 of the Code of Federal Regulations, in the outstanding Official Action establishes that the claims of the present application are indeed not distinctive and independent of each other.

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It is emphasized that 37 C.F.R. §1.141(a) indicates that although two or more independent distinct inventions may not be claimed in one national application an exception is drawn to species of an invention. A reasonable number of species, as in the present application, may be claimed provided that the application includes an allowable claim generic to all the claimed species.

So it is in the present application. The claimed classes of species that the Official Action avers are unpatentable over each other is permissible. It goes without saying that if any of these species were known in the prior art they would indeed invalidate the other species. However, there is no basis for the outstanding Official Action imposition of the restriction requirement of record based on this alleged fact, which, of course, applicants strongly deny.

It is also further mentioned in passing that restriction requirements are usually supported by one or more sections of Chapter 800 of the Manual of Patent Examining Procedure. It is noted that no reliance on any section of the MPEP is advanced in support of the restriction requirement of record in the outstanding Official Action.

Reconsideration and removal of the restriction requirement of record is therefore deemed appropriate. Such action is respectfully urged.

The Official Action also imposes a species election to which the claims of the present application shall be limited in the event that a generic claim is not found patentable.

Applicants have elected the species (Z) 2-(5-(4-(Hexyl-methyl-amino)-benzylidene)-4-oxo-2-

thioxo-thiazolidin-3-yl)-ethanesulfonic acid, as that elected species. Applicants submit that all of Claims 1-11 read on this species.

Applicants traverse the requirement for a species election. Applicants note, however, that even if a species election was appropriate, which they deny, that that election does not reduce the scope of claims within the contemplation of the invention embodied by the elected species insofar as all of Claims 1 to 11 read on that species.

Applicants' traverse is predicated upon the well established principle that a species election is not appropriate where a limited number of species are within the scope of a claimed genus. So it is in the present application. The present application is directed to a genus whose species are within a reasonable number, not necessitating a species election.

The above remarks establish that the restriction requirement and species election of record should be rescinded. Such action, followed by prompt examination on the merits of all the claims currently in this application, Claims 1-11, is therefore respectfully solicited.

Respectfully submitted,



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